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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,381	09/23/2003	David E. Bostdorf	11393.00	6065

29994 7590 01/12/2006  
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EXAMINER

WATKINS III, WILLIAM P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/668,381

Applicant(s)

BOSTDORF, DAVID E.

Examiner

William P. Watkins III

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The rejection using Spencer given in section 3 of the office action mailed 25 August 2005 is withdrawn, except for claims 1 and 2, in view of applicant's amendments to claims 3 and 20 limiting the claims to loose stationary sheets.
2. The amendment to the specification in the response filed 24 October 2005 has been entered.
3. Applicant's arguments, regarding the modifications to the restriction requirements given in section 1 of the detailed portion of the office action mailed 25 August 2005, have been considered, even though it was indicated that the requirement was made final. The examiner continues to maintain that there is burden in fully searching the method claims that goes beyond that required for the article claims. The examiner has reviewed 37 C.F.R. 1.104 and can find no language that prohibits restricting article and method claims. The restriction requirement is again made final.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Spencer (U.S. 3,900,629).

The reference shows a stack of sheet layers with openings cut in the sheet layers, with the openings being offset between alternate layers of the stack (abstract, Figure 1). The examiner does not give specific weight to the openings being die cut as it is not clear how hole formation by this means differs from hole formation by another means such as laser cutting. This said, the examiner notes that the reference at col. 3, lines 60-65, teaches using stamping to form the openings, which the examiner takes as a form of cutting with a die.

6. Claims 1-9, 11-12, 20-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by May (U.S. 5,447,299).

See Figure 3, which shows offset holes in different layers, which prevent jamming, as well as straight die cuts adjacent

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circular holes, and side folds on each side of the central area. No specific weight is given to the method of hole formation as noted above.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3-12 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions of a commercial product that holds key cards (paragraphs 005 and 009) and has die cuts and May (U.S. 5,447,299).

Applicant admits that a keycard holder configuration of silts in a folded sheet is in commercial use. May teaches offsets in openings in stacked sheets to allow entry of air and prevent jamming when printing various sheet products such as cards (col. 4, lines 45-65, col. 6, lines 45-55). The instant invention claims curved and straight cut areas in a sheet with a central portion and two side portions. It would have been

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obvious to one of skill in the art to have offset the openings in the stacks of the admitted cardholder of applicant in order to prevent jamming when feeding the sheets into various processing machines. The degree of offset between features in alternating layers being within the ordinary skill of the art absent unexpected results.

9. Applicant's arguments filed 24 October 2005 have been fully considered but they are not persuasive.

As a matter of claim construction, the examiner takes a diecut as being an opening or aperture in a sheet that extends through the sheet, as elements 16 are disclosed in the specification as allowing insertion of a key through the sheet. The construction of the examiner does not limit the method of aperture formation to the process of cutting with a die as many other methods such as laser cutting or even sawing can produce similar shaped holes. Applicant argues that the edge roughness of holes formed by different methods may differ, but no specific edge roughness is claimed and no evidence has been presented that cutting dies are inherently limited to a specific configuration that produces a specific hole edge roughness. See

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MPEP 2113 for the weight given to process limitations in article claims.

Applicant's arguments regarding Spencer as applied to claims 1 and 2 are not accepted. Applicant argues that Spencer does not show diecuts. The examiner disagrees as the reference shows openings that meet the examiner's construction diecuts as noted above. Regarding the patterns of Spencer repeating, Figure 1 shows a top layer that appears to have the same slit pattern as the third layer from the top. The top and second layers have offset slit patterns that appear to be otherwise identical.

Regarding the 102 rejection using May, applicant again argues that there are no diecuts taught. The examiner disagrees. The reference clearly shows openings with straight and curved edges (elements 25, 26, 25a, 26a, and 30), that could be formed by cutting of the sheets with dies, that alternate in an offset fashion between adjacent sheets as in Figures 3 and 8.

Regarding the 103 rejection using May and applicant's admission, applicant argues that May is not analogous art. The examiner disagrees. Applicant's specification is directed to a paperboard sheet that serves as a container for a key. May is directed to paperboard sheets used as packaging (col. 6, lines

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40-60). The reference and the specification would appear not only to be analogous art, but also to be in the same art area.

The examiner notes that the teachings of May are directed to gravity feed of sheets as well as vacuum feed (col. 2, lines 50-65). The problem of sheets sticking together would be involved during automated production using sheets of the admitted prior art key holders disclosed by applicant. It would have been obvious to one of ordinary skill in the art have placed offset notches in the admitted key holders, or have put protrusions and offset the key holding apertures in relation to each other and the protrusions between sheets, in order to allow the sheets to be separated, when fed into an automated process as taught by May. The sheets of May are taught as being substantially identical and interchangeable in use except for the offset location of the notches, holes and protrusions, which aide in separation of the sheets (col. 8, lines 40-60).

The examiner appreciates applicant's often expressed desire in the amendment filed 24 October 2005, that the claimed invention not be over broadly constructed and that all relevant art be found and applied. The examiner notes that applicant controls the ultimate construction of the claims, as applicant can amend them to have any desired scope that is supported by



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the specification. Applicant is also free to conduct an independent search and submit art in an information disclosure statement, if applicant wishes to insure that all possible relevant art is considered by the examiner. The duty of the examiner is to construct the claims as presented and establish the patentability of the presented claims by search and application of relevant prior art. This has been done in the above sections.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

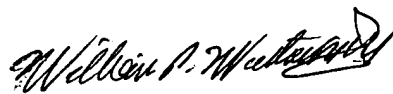
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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**

WW/ww

January 8, 2006